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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,496	03/23/2004	Michael Saigh	AUTOCART	4385
34534 7590 12/09/2008 KEVIN LYNN WILDENSTEIN 9400 HOLLY AVENUE NE BUILDING 4H ALBUQUERQUE, NM 87122				
EXAMINER SHAPIRO, JEFFERY A				
ART UNIT		PAPER NUMBER		
3653				
MAIL DATE		DELIVERY MODE		
12/09/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/807,496

**Applicant(s)**

SAIGH ET AL.

**Examiner**

JEFFREY A. SHAPIRO

**Art Unit**

3653

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 44-132 is/are pending in the application.
- 4a) Of the above claim(s) 52-55, 58, 77, 78, 83, 90, 105-108, 111 and 118 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-51, 56, 57, 59-64, 66-76, 80-82, 84-89, 91-104, 109, 110, 112-117 and 119-132 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 44-49, 51, 56, 59-63, 66-76, 80-81, 84-88, 91-104, 109, 112-116 and 119-132 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. With respect to Claim 44, the term "introducing" is still unclear. Applicant has stated that the term "introducing" is defined as, i.e., refers to "identifying, bringing into play or using at least one core computer." See Applicant's response of 8/13/08 at p. 21, lines 4-9. The use of three different definitions of varying breadth makes Claim 44 and any other Claim using the word "introducing" unclear as to the "scope of the claim". The term "using" is broad enough to encompass the other two definitions while the term "identifying" is specific as to denote making the "core computer system" known to the system through an address. The term "bringing into play" is a colloquialism which could mean identifying or "turning on" the computer.
4. The cited claims are replete with unclear language. Some examples include:
5. Claim 44: The term "introducing" is unclear.
6. Applicant's amendment of Claims 57, 64, 82, 89, 110 and 117 are acknowledged and appear to be according to proper practice.

7. However, regarding Claims 49 and 97, Applicant asserts that these claims do not recite an Improper Markush Group because the recitations in those claims "identify various technologies in which the claimed electronic means **may** communicate." Emphasis provided. See Applicant's response, p. 21, second to last paragraph. If these claims are not intended to recite a Markush Group, then it is posited that they are nonetheless unclear because it is not certain if all of the modes or formats of communication are handled by the electronic means, a few of them, or only one of them. For example, it appears from the Claim language of Claims 49 and 97 that **all modes and formats** are handled by the electronic means.
8. In Claim 128, it is unclear what the term "specials" refers to. Additionally, note that this term does not appear anywhere in the specification.
9. It is suggested that all claims be amended accordingly so as to conform to U.S. practice.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 44-51, 56-57, 59-61, 66-76, 80-82, 84-85, 91-104, 109, 110, 112-114, and 119-132 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kipp (US 5,890,136) in view of Domain et al (US 5,158,155).

12. Regarding Claims 44, 80, 85, 96, 99, 100, 124-127 and 132, Kipp discloses a structural facility (16), as illustrated in figure 5, that receives and distributes items, including a central order processing portion, a plurality of drive-through pick up areas (14), a central, i.e., core computer (20) that communicates with customers through communications system (18), mentioned at col. 4, line 65-col. 5, line 20.

13. Further regarding Claim 128, note that Kipp at col. 5, lines 12-34 recites preordering communication means in the form of implementing communication over a data network or a telephone network.

14. Regarding Claim 129 and 131, Kipp discloses verifying customer identification, order information and payment processing at col. 5, lines 12-34. Note that the world wide web, a data network and a phone network all incorporate remote computer devices.

15. Further regarding Claim 96, note that the last four lines are considered conditional language which does not further limit the claim since these conditions may never occur. The last six lines of Claim 99 similarly are non-limiting.

16. Regarding Claim 44, Kipp does not expressly disclose, but Domain discloses a computer-controlled traffic optimization system for the purpose of optimizing traffic flow through a drive-up retail facility. See Domain, col. 5, lines 40-61.

17. Regarding Claim 45, Domain further discloses plural staging lanes (14) in communication with the core computer system.

18. At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added a computer-controlled traffic optimization system, as taught by Domain, in Kipp's drive-through retail facility, for the purpose of optimizing traffic.

19. Regarding Claims 46, 71, 128, Kipp discloses an order placement, i.e., preordering communication means (18), mentioned at col. 4, line 65-col. 5, line 20, and delivery station (24), described at col. 6, lines 39-col. 7, lines 1-7.

20. Regarding Claim 47, note that Kipp's station (24) receives items on conveyor (44).

21. Regarding Claims 48, 49, 73 and 74, 97, 101, Kipp's station (24) communicates by hardwired or wireless means with the central (core) computer. See Kipp at col. 4, line 62-col. 5, line 25.

22. Regarding Claims 50, 75, 103, note that Kipp's communication means includes pre-ordering/sale information. See Kipp at col. 7, lines 30-40.

23. Regarding Claims 51, 56, 57, 76, 81, 82, 98, 104, 109, 110, Kipp's pre-ordering means verifies customer orders and identification, as mentioned at col. 6, lines 25-29 and 45-63. Note that biometrics are disclosed at lines 45-47.

24. Regarding Claims 59, 60, 61, 102, 112, 113, 114, official notice is taken that it would have been obvious to incorporate an area to handle special goods, provide refunds, receive returns or handle customer queries/customer service, as typical retail establishments are well-known to have such an area.

25. Regarding Claims 66-70, 91-95, 119-123, note that Kipp's structural facility is "adapted" to be attached to any other desired structure, such as a strip mall, box store, outdoor mall, indoor mall or other structure.
26. Regarding Claim 72, note that service items are considered functional equivalents of other items. Regardless of the item, Kipp's apparatus is adapted to handle service or other items.
27. Claims 62-64, 86-89, 115-117, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kipp (US 5,890,136) in view of Dickson (US 6,810,304 B1).
28. Kipp discloses the drive-through retail structure as described above.
29. Kipp does not expressly disclose, but Dickson discloses a food area (22) with a food prep area (40), as illustrated in figure 1 of Dickson, for the purpose of expanding retail offerings in order to increase sales and thus profits.
30. At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added a food area with food prep area, such as a restaurant, as taught by Dickson, in Kipp's drive-through retail facility, for the purpose of expanding retail offerings and increasing profits.
31. Official notice is taken that such food areas require refrigerated areas as well as environmental controls, for example.

***Response to Arguments***

32. Applicant's arguments filed 8/13/08 have been fully considered but they are not persuasive.

The recent decision rendered in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007) forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness. See recent Board decision *Ex Parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>).

Applicant asserts that Applicant's claims do not read on the Kipp's automated ordering system because Kipp's system discloses four alleged separate components, i.e., an interactive system for communicating a customer's order, a host computer to receive and process a customer's order, a system for retrieving articles and a system for retrieving identification information from the customer.

However, such a designation of a single system versus components is a relative concept. Kipp's alleged four identified systems can be construed as "subsystems" which form a collective whole or overall automated ordering system, as represented by figure 1 of Kipp. Additionally, Applicant's claims do not foreclose Kipp's single automated ordering system from being considered as a single system. Inasmuch as Applicant's system comprises parts, modules or subsystems, Kipp's ordering system includes the same structural and functional entities as described in Applicant's claims.

Regarding use of Domain, note that legally sufficient and proper motivation exists as Domain teaches a traffic optimization system for drive-in establishments. Since



Kipp's device is a drive-in establishment, it would have been logical for one ordinarily skilled to have used Domain's teaching since Kipp's system would also be expected to exhibit volumes of traffic which if optimized would contribute to better efficiency and throughput of Kipp's system.

Regarding use of Dickson, note that Dickson teaches adding a food prep area. Since Kipp teaches an automated retail ordering system, and food is an item that is sold in commerce, it would have been apparent to one of ordinary skill in the art to offer food through Kipp's ordering system since it would expand retail offerings thus resulting in increased sales and thus increased profits. Note also that Kipp's system is intended to be a for-profit enterprise, as evidenced by the inclusion of payment means such as credit.

### ***Conclusion***

33. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY A. SHAPIRO whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Shapiro/  
Primary Examiner, Art Unit 3653

December 8, 2008